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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/766,531 | 01/29/2004 | Jianwen Ni | 005242.00103 | 2230 |
| 22907 | 7590 | 02/25/2005 | EXAMINER | |
| BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001 | | | RAJGURU, UMAKANT K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,531

Applicant(s)

NI ET AL.

Examiner

Umakant K. Rajguru

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Claims 1-58 are presented for examination.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

Claim 1 is vague in reciting "a wood composite product" comprising "wood composite product" (lines 1 & 2).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1-12, 15-18, 22-39, 42, 44-53, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al (US 4898776) in view of Eek-Vancells (EP 715935) or Luetgert et al (US 6610164).

Israel describes a synthetic board prepared by contacting a lignocellulosic material with a binder (abstract). Wood particles are suitable as a lignocellulosic material (col. 3, lines 56). Binder includes thermosetting resins (col. 10, lines 37-43). A surfactant is added to the binder (col. 2, line 35). Suitable surfactants are a condensate of cetyl alcohol with analogous ethylene oxide (col. 4, lines 59-61), derivatives of tall oil fatty acid (col. 4, lines 57-59), oleic acid (col. 4, line 57) and amines (col. 4, lines 65-67).

Israel does not mention an overlay affixed to the face of the board.

Eek-Vancells discloses a process for covering particle board.

Luetgert also discloses a method of selectively coating a wood composite.

Therefore it would have been obvious from the teachings of Eek-Vancells or Luetgert, to apply a layer of a suitable material to surface/s of the particle board of Israel in order to present an aesthetic and pleasing appearance which resembles that of natural wood.

6. Claims 13, 14, 19, 20, 21, 40, 41, 43, 54 & 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al (US 4898776) in view of Eek-Vancells (EP 715935) or Luetgert et al (US 6610164) as applied to claims 1, 12, 39, 53 (as appropriate) above, and further in view of West et al (US 2003/0040562).

Combination of Israel and Eek-Vancells or Luetgert does not mention triethylamine.

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West discloses a composition for wood sealer wherein triethyl amine is used

It would hve been obvious to use triethylamine in the composition of particles board of Israel since triethylamine is known to act as a catalytic solvent for curing and hardening of polymeric matrices.

7. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al (US 4898776) in view of West et al (US 2—3/0040562).

Israel (whose disclosure is presented earlier) does not mention triethylamine which is however taught by West.

It would have therefore been obvious to prepare a composition (from teaching of Israel) comprising thermosetting resin, tall oil fatty acid and add to it triethylamine (taught by West) for solvation, curing and hardening.

8. Claims 27 & 52 contains the trademark/trade name “mylar”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a polyester film and, accordingly, the identification/description is indefinite.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru whose telephone number is (571) 272-1077. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



U. K. Rajguru/af
February 9, 2004



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700